REMARKS

Claims 2-7, 9-14 and 16-17 were pending in the Application. Claims 9-14 and 16-17 are cancelled without prejudice or disclaimer. Claim 20, corresponding to originally filed claim 1, was added. Hence, claims 2-7 and 20 are pending.

Applicants cancelled claims 9-14 and 16-17 so as to prosecute all method claims in one patent application. Applicants are not conceding in this application that cancelled claims 9-14 and 16-17 are not patentable over the art cited by the Examiner. Claims 9-14 and 16-17 were cancelled solely to facilitate expeditious prosecution of the remaining method claims (claims 2-7 and 20). Applicants respectfully reserve the right to pursue these (claims 9-14 and 16-17) and other claims (e.g., originally filed claims 8, 15, 18 and 19) in one or more continuation patent applications.

As discussed above, claim 20, corresponding to originally filed claim 1, was added. Applicants amended claim 2 to be dependent upon claim 20 thereby amending claim 2 to be restated in its original dependent form. Claim 2 was not amended to overcome prior art. Hence, no prosecution history estoppel arises from the amendment to claim 2. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendment made to claim 2 was not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such an amendment. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

Claims 2-7, 9-14 and 16-17 are rejected under 35 U.S.C. §103(a). Applicants address these rejections below in connection with pending claims 2-7 and 20.

I.   REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 2-5 and 20 under 35 U.S.C. §103(a) as being unpatentable over Garnett et al. (U.S. Patent No. 7,032,037) (hereinafter "Garnett") in view of McCormick et al. (U.S. Patent Application Publication No. 2002/0083260) (hereinafter "McCormick"). The Examiner has further rejected claims 6-7 under 35 U.S.C. §103(a) as being unpatentable over Garnett in view of

McCormick and in further view of Berg (U.S. Patent Application Publication No. 2002/0116475) (hereinafter "Berg"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

    A.   <u>Claims 2-5 and 20 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Garnett in view of McCormick.</u>

    1.   <u>Garnett and McCormick, taken singly or in combination, do not teach at least the following claim limitations.</u>

Applicants respectfully assert that Garnett and McCormick, taken singly or in combination, do not teach "bundling said request message and information from said handshake messages involved in establishing said TCP connection by said network processor" as recited in claim 20. The Examiner cites column 36, lines 52-56 of Garnett as teaching the above-cited claim limitation. Office Action (11/1/2007), page 4. Applicants respectfully traverse.

Garnett instead teaches that in HTTP, usually the first data packet contains the request so the first data packet, after the three-way handshake, is parsed to make the load balancing decision. Column 36, lines 52-54. Garnett further teaches that after the load balancing decision has been made, the connection to the load balancer is handed over to the selected server. Column 36, lines 54-56.

Hence, Garnett teaches parsing a data packet to make the load balancing decision.

There is no language in the cited passage that teaches <u>bundling the request message and information form the handshake messages</u>. Neither is there any language in the cited passage that teaches bundling the request message and information from the handshake messages involved in establishing the TCP connection <u>by the network processor</u>. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 20, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Garnett and McCormick, taken singly or in combination, do not teach "transmitting said bundled message to said control processor by said network processor" as recited in claim 20. The Examiner cites column 29, lines 23-24 and column 33, lines 13-20 of Garnett as teaching the above-cited claim limitation. Office Action (11/1/2007), page 4. Applicants respectfully traverse.

Garnett instead teaches that management control of the web farm 360 can be provided through a pair of System Management Servers (SMSs) 362. Column 29, lines 23-24. Garnett further teaches that when a server responds to a received data packet, the outgoing packet is transmitted from the server 505 to the load balancer 501, which forwards the outgoing packet to the outside network. Column 33, lines 13-16. Garnett additionally teaches that the incoming packet arrives at the switch 73, travels to the load balancer 501 and is then passed to a processing cartridge 43 via the switch 73. Column 33, lines 18-20.

Hence, Garnett teaches that when a server responds to a received data packet, the outgoing packet is transmitted form the server to the load balancer. Garnett further teaches that the incoming packet travels to the load balancer and is then passed to a processing cartridge via a switch.

There is no language in the cited passages that teaches transmitting a bundled message. Neither is there any language in the cited passages that teaches transmitting a bundled message to a control processor. Neither is there any language in the cited passages that teaches transmitting a bundled message to a control processor by a network processor. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 20, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Claims 2-5 each recite combinations of features of independent claim 20, and hence claims 2-5 are patentable over Garnett in view of McCormick for at least the above-stated reasons that claim 20 is patentable over Garnett in view of McCormick.

Claims 2-5 recite additional features, which, in combination with the features of the claims upon which they depend, are patentable over Garnett in view of McCormick.

For example, Garnett and McCormick, taken singly or in combination, do not teach "identifying a server in a server farm to service said client's request message by said control processor" as recited in claim 2. The Examiner cites column 29, lines 23-24 of Garnett as teaching the above-cited claim limitation. Office Action (11/1/2007), page 4. Applicants respectfully traverse.

As stated above, Garnett instead teaches that management control of the web farm 360 can be provided through a pair of System Management Servers (SMSs) 362. Column 29, lines 23-24.

There is no language in the cited passage that teaches identifying a server in a server farm to service the client's request message. Neither is there any language in the cited passage that teaches identifying a server in a server farm to service the client's request message by the control processor. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 2, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Garnett and McCormick, taken singly or in combination, do not teach "bundling said client's request message and a control message by said control processor" as recited in claim 2. The Examiner cites paragraph [0035] of McCormick as teaching the above-cited claim limitation. Office Action (11/1/2007), page 5. Applicants respectfully traverse.

McCormick instead teaches that in order to facilitate interaction between the various intermediate processors 230-234 and the line cards included in the switch, a message processor 250 may be included in the multiprocessor control block 110. [0035]. McCormick further teaches that the message processor 250, which is operably coupled to the plurality of intermediate processors 230-234 and the plurality of line cards included in the switch, supports messaging between the plurality of intermediate processors 230-234 and one or more of the line cards. [0035]. Further,

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McCormick teaches that the message processor 250 may act as a queuing point for messages between the intermediate processors 230-234 and the line cards, where multiple messages are bundled together for distribution to the various line cards in order to improve the efficiency with which such messages are communicated. [0035].

Hence, McCormick teaches a message processor acting as a queuing point for messages between the intermediate processors and the line cards, where multiple messages are bundled together for distribution to the various line cards.

There is no language in the cited passage that teaches bundling the client's request message and a control message. Instead, McCormick teaches bundling messages between the intermediate processors and the line cards. Neither is there any language in the cited passage that teaches bundling the client's request message and a control message by the control processor. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 2, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Garnett and McCormick, taken singly or in combination, do not teach "transmitting said bundled message comprising said client's request message and said control message to said network processor" as recited in claim 2. The Examiner cites column 40, lines 31-32 of Garnett as teaching the above-cited claim limitation. Office Action (11/1/2007), page 4. Applicants respectfully traverse.

Garnett instead teaches that a control microprocessor 530 performs management tasks for the load balancer 501. Column 40, lines 31-32.

There is no language in the cited passage that teaches transmitting a bundled message. Neither is there any language in the cited passage that teaches transmitting a bundled message comprising the client's request message and the control message. Neither is there any language in the cited passage that teaches transmitting a bundled message comprising the client's request message and the control message to the network processor. Therefore, the Examiner has not presented a *prima facie* case of

obviousness in rejecting claim 2, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Garnett and McCormick, taken singly or in combination, do not teach "wherein said server in said server farm is identified using information extracted from said client's request message" as recited in claim 3. The Examiner cites column 1, lines 53-56 of Garnett as teaching the above-cited claim limitation. Office Action (11/1/2007), pages 5-6. Applicants respectfully traverse.

Garnett instead teaches that the modular computer system may also comprise a switch operable to connect to the internal communications network to distribute information messages between the modules and to connect to an external communications network. Column 1, lines 52-56.

Hence, Garnett teaches a switch operable to connect to the internal communications network to distribute information messages between the modules and to connect to an external communications network.

There is no language in the cited passage that teaches a server in a server farm. Neither is there any language in the cited passage that teaches a server in a server farm is identified using information extracted from the client's request message. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 3, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Garnett and McCormick, taken singly or in combination, do not teach "wherein said control message comprises information used to enable said network processor to create entries in a forwarding table to ensure packets from said client are transmitted to said server and to ensure packets from said server are transmitted to said client" as recited in claim 4. The Examiner cites column 40, lines 37-38 of Garnett as teaching the above-cited claim limitation. Office Action (11/1/2007), page 6. Applicants respectfully traverse.

Garnett instead teaches that control microprocessor 570 also has programming to keep rule tables for the network processing unit 520 and the classification engine 528 up to date. Column 40, lines 36-38.

There is no language in the cited passage that teaches a control message. Neither is there any language in the cited passage that teaches a control message that comprises information used to enable the network processor to create entries in a forwarding table. Neither is there any language in the cited passage that teaches a control message that comprises information used to enable the network processor to create entries in a forwarding table to ensure packets from the client are transmitted to the server. Neither is there any language in the cited passage that teaches a control message that comprises information used to enable the network processor to create entries in a forwarding table to ensure packets from the server are transmitted to the client.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 4, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

2.   Examiner's reasoning for modifying Garnett with McCormick to include the missing claim limitation of claim 2 is insufficient to establish a *prima facie* case of obviousness.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id*. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id*. In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some

rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)).

As understood by Applicants, the Examiner admits that Garnett does not teach "bundling said client's request message and a control message by said control processor" as recited in claim 2. Office Action (11/1/2007), pages 4-5. The Examiner asserts that McCormick teaches the above-cited claim limitation. *Id.* at page 5. The Examiner's reasoning for modifying Garnett with McCormick to include the above-cited claim limitation is "for the purpose of efficient capacity and high speed communications." *Id.* The Examiner's reasoning is insufficient to establish a *prima facie* case of obviousness in rejecting claims 2-5.

As further understood by Applicants, the Examiner cites paragraph [0035] of McCormick as support for the Examiner's reasoning for modifying Garnett with McCormick to include the above-cited missing claim limitation of claim 2. McCormick teaches that the message processor 250 may act as a queuing point for messages between the intermediate processors 230-234 and the line cards, where multiple messages are bundled together for distribution to the various line cards in order to improve the efficiency with which such messages are communicated. [0035]. Hence, McCormick teaches a message processor acting as a queuing point for messages between the intermediate processors and the line cards, where multiple messages are bundled together for distribution to the various line cards in order to improve the efficiency with which such messages are communicated.

There is no language in McCormick (and in particular paragraph [0035]) that makes any suggestion to bundle the client's request message and a control message by the control processor (missing claim limitation) for the purpose of efficient capacity and high speed communications (Examiner's reasoning). The Examiner has to provide some rational connection between the cited passage that is the source of the Examiner's reasoning and the above-cited missing claim limitation. The Examiner's source of reasoning (paragraph [0035] of McCormick) does not provide reasons as to why one skilled in the art would modify Garnett to include the above-cited missing

claim limitation of claim 2. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 2-5. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

Further, the Examiner's reasoning ("for the purpose of efficient capacity and high speed communications") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Garnett to include the above-indicated missing claim limitation of claim 2. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 2-5. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007); *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

There are many ways to improve efficiency and high speed communications. The Examiner though must explain as to why in particular one skilled in the art would modify Garnett <u>to bundle the client's request message and a control message by the control processor</u> (missing claim limitation) in order to improve efficiency and high speed communications.

Hence, the Examiner's rationale does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Garnett to include the above-cited missing claim limitation of claim 2. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 2-5. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007); *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

B.   <u>Claims 6-7 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Garnett in view of McCormick and in further view of Berg.</u>

The reference Berg, which only qualifies as prior art under 35 U.S.C. §102(e), does not preclude patentability under 35 U.S.C. §103 since Berg and the claimed invention in claims 6-7 were at the time the invention was made, subject to an obligation of assignment to the same person, which in this case was International

Business Machines Corporation. Thus, Berg is disqualified as being used as a prior art reference under 35 U.S.C. §103(c). Consequently, the rejections of claims 6-7 are moot.
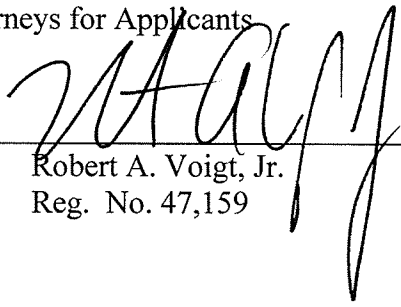
II.   CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 2-7 and 20 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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